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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,347	02/15/2002	Benjamin A. Pines	P56660	8906

7590 02/22/2007
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Suite 300
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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/075,347	Applicant(s) PINES, BENJAMIN A.	
	Examiner Gerald Gauthier	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. **Claim(s) 7, 9, 14, 15, 19- 22 and 27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "less than" "not more" in **claim 7** is a relative term, which renders the claim indefinite.

The term "less than" in **claim(s) 9, 14, 15, 22 and 27** is a relative term which renders the claim indefinite.

The term "not to exceed" in **claim(s) 19, 20 and 21** is a relative term which renders the claim indefinite.

Claim(s) 10-12, 16-18, 23-31 are rejected as being dependent of rejected claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2614

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claim(s) 1-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al. (US 6,356,626 B1) in view of Johnson et al. (US 5,063,698).

Regarding **claim(s) 1**, Ohara discloses a sound producing display system (column 1, lines 9-15), comprising:

a postcard capable of playing back a customized message (column 12, lines 1-4), said postcard comprising:

a memory storing the customized message as an audio message (column 9, lines 41-51);

a playback button borne by said postcard enabling a user to manually initiate playback of said audio message stored in said memory (column 9, lines 53-64);

a speaker disposed to convert said audio message from said memory into audible sounds (column 10, lines 20-36);

a battery energizing said postcard and said system (column 12, lines 13-16); and
an audio board having an IC voice synthesizer chip attached thereto, said audio board being operationally connected to said system when said postcard is removably

inserted into said system to accommodate recordation of the customized message in said memory (column 14, lines 1-15).

Ohara fails to disclose a postcard.

However, Nozaki teaches a postcard (column 12, lines 19-35).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Ohara using the teaching of greeting postcard as taught by Nozaki.

This modification of the invention enables the system to send a postcard so that the user would receive the greeting postcard by mail.

Regarding **claim(s) 2 and 28**, Ohara discloses a system, said recording unit further comprising an LED that turns on when said microphone is activated (column 11, lines 51-64).

Regarding **claim(s) 3, 10, 12 and 13**, Ohara discloses a system further comprising: a recording unit comprising: a microphone recording the customized message onto said postcard: a slot accommodating insertion of said postcard (column 13, lines 17-35);

a plurality of electrical connectors forming an electrical contact to said postcard: and a record button to activate said microphone to allow the customized message to be recorded on said postcard (column 13, lines 17-35).

Regarding **claim(s) 4 and 17**, Ohara discloses a system, said memory comprising an EEPROM being automatically overwritten by a subsequently recorded message (column 13, lines 17-35).

Regarding **claim(s) 5, 11, 23, 30 and 31**, Johnson teaches a system, said postcard being 5.5mm thick and capable of being mailed through the postal service (column 3, lines 52-68).

Regarding **claim(s) 6, 16, 24, 26 and 29**, Ohara discloses a system, with said recording unit being absent a power supply when said postcard is not electrically connected to said system (column 13, lines 17-35).

Regarding **claim(s) 7, 15, 21, 25 and 27**, Ohara discloses a system, with said recording unit having a width less than 7.25 inches and a height of not more than 4 inches (column 14, lines 1-15).

Regarding **claim(s) 8, 18, 20 and 22**, Ohara discloses a system, with said postcard having a plurality of guide slots to mate with corresponding ones of a plurality of guide pins on said recording unit so that a plurality of electrical fingers emanating from said audio board of said postcard mate with corresponding ones of said plurality of electrical connectors on said recording unit (column 14, lines 1-15).

Regarding **claim(s) 32**, Nozaki teaches a postcard, further comprising: a pair of vinyl layers, one being on each side of the postcard, the vinyl layers being adapted to allow a user to write a message thereon (column 12, lines 19-35); and

foam arranged on portions of a space between the vinyl layers absent the PCB (column 12, lines 19-35).

Regarding **claim(s) 33**, Nozaki teaches system, the postcard further comprising a foam layer arranged within the postcard underneath the vinyl in portions absent said PCB (column 12, lines 19-35).

Response to Arguments

7. Applicant's arguments filed December 19, 2006 have been fully considered but they are not persuasive. Regarding the argument for the 35 U.S.C. 112, second paragraph, the examiner disagrees.


Regarding the claims ejected under 112, the phrases "less than", "not to exceed" render the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Therefore the rejection under needs to be addressed.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gerald Gauthier
Examiner
Art Unit 2614

GG
February 12, 2007